

REMARKS

In the Final Office Action,¹ the Examiner (A) objected to the specification; (B) rejected claims 1, 2, and 25 under 35 U.S.C. § 112, second paragraph; (C) rejected claims 1-5, 7-13, 19-20, 25-31, and 33-36 under 35 U.S.C. § 103(a) over U.S. Patent No. 5,721,906 (Siefert) in view of U.S. Patent Application Publication No. 2003/0130994 (Singh); (D) rejected claims 6, 14-16, 18, and 32 under 35 U.S.C. § 103(a) over Siefert in view of Singh and further in view of U.S. Patent Application Publication No. 2005/0086204 (Coiera); and (E) rejected claim 17 under 35 U.S.C. § 103(a) over Siefert in view of Singh in view of Coiera and further in view of U.S. Patent No. 6,636,837 (Nardozzi).

Claims 1, 3-25, and 27-36 are pending in this Application. By this amendment, Applicants propose to amend claims 1, 3, 25, and 27, and propose to cancel claims 2 and 26 without prejudice or disclaimer. No new matter is added.

A. Objection To The Specification

The Final Office Action objects to the specification for allegedly failing to provide proper antecedent basis for the claim terms “first attributes” and “second attributes.” This objection is respectfully traversed.

There is “no requirement that the words in the claim must match those used in the specification or disclosure.” MPEP § 2173.05(e). Indeed, so long as the terms and phrase define the invention with a reasonable degree of clarity and precision, Applicants

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

are given a great deal of latitude in how they choose to define their invention. MPEP § 2173.05(e).

The meaning of the claim terms “first attributes” and “second attributes” are clearly ascertainable by reference to the specification, and these terms define the claims with more than a reasonable degree of clarity and precision. Therefore, withdrawal of the objection is respectfully requested.

B. Rejection of Claims 1-2 and 25 Under 35 U.S.C. § 112

The Final Office Action rejects claims 1-2 and 25 under 35 U.S.C. § 112, second paragraph for allegedly being unclear about which specific type of attributes are “first” or “second” attributes. This rejection is respectfully traversed.

A fundamental principle contained in 35 U.S.C. § 112, second paragraph, is that applicants are their own lexicographers. MPEP § 2173.01. Furthermore, it is improper to require that Applicants be limited to embodiments explicitly described in the specification. As the meaning of the terms “first attributes” or “second attributes” are clearly ascertainable, as discussed in Section A above, and because Applicants are not limited to specific embodiments described in the specification, withdrawal of the rejection is respectfully requested.

C. Rejection of Claims 1-5, 7-13, 19-20, 25-31, and 33-36 Under 35 U.S.C. § 103(a)

The Final Office Action rejects claims 1-5, 7-13, 19-20, 25-31, and 33-36 under 35 U.S.C. § 103(a) over Siefert in view of Singh. This rejection is respectfully traversed because a *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2154. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. § 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

In this application, a *prima facie* case of obviousness has not been established because the Final Office Action has neither properly determined the scope and content

of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Final Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Applicants propose to amend claim 1 to incorporate elements of claim 2. As proposed, claim 1 recites, in part, “wherein the first and second attributes have dimensions, the method further comprising: creating segments of the hit-list by grouping the resources by one of the attribute dimensions and displaying statistics associated with the segments; receiving a selection of segments through the user interface; and providing a narrowed hit-list by selecting one or more resources from the selected segments.” Claim 25 is proposed to be amended to include similar elements.

The Final Office Action asserts that Siefert discloses the claimed first attributes, and that Singh’s “authors” and “publishers” correspond to the claimed second attributes. Final Office Action, page 5. The Final Office Action further asserts that Singh discloses creating the claimed segments because Singh displays statistics, such as the number of authors, number of titles, and number of publications “with each segment of authors or publishers.” Final Office Action, page 6.

Assuming, *arguendo*, that the Final Office Action’s assertion that “authors” and “publishers” correspond to the claimed second attributes is correct, Singh cannot teach creating segments of the hit-list by grouping the resources *by one of the attribute dimensions*. In contrast, Singh merely discloses displaying summary statistics relating to “authors” and the like. Furthermore, the selection of one of Singh’s alleged second attributes “merely select[s] subsets of the existing results tables,” (Singh, paragraph

[0163]) which again would merely display summary statistics relating to alleged second attributes, and not to attribute dimensions. Therefore, Singh fails to create segments of the hit-list by grouping the resources by one of the attribute dimensions. As Singh fails to create the claimed segments, Singh also fails to teach or suggest “receiving a selection of segments through the user interface; and providing a narrowed hit-list by selecting one or more resources from the selected segments,” as recited in claim 1.

In view of the above, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Final Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1.

Furthermore, the Final Office Action’s characterization of the applied references with respect to the dependent claims is also incorrect. For example, the Final Office Action asserts that Singh and Siefert disclose providing the hit-list as a collection of items that can be used for further actions or stored as a persistent collection, as recited in claim 4. Specifically, the Final Office Action asserts that the features of claim 4 are disclosed in Siefert because Siefert provides a user “with a retrieved collections [sic] of hit list which can be used for further action of reviewing *implying* that the hit-list of resources are stored before the retrieving” (emphasis added). See Final Office Action, page 8. However, Siefert discloses no such feature.

First, the portions of Siefert cited in the Final Office Action merely discuss retrieving (i.e., downloading) a resource. See col. 11, lines 10-15. Such a disclosure

does not teach providing a hit-list as a collection of items that can be used for further actions or stored as a persistent collection, as recited in claim 4. Furthermore, the Final Office Action's assertion that Siefert's disclosure *implies* (i.e., inherently discloses) the features of claim 4 is improper, as the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. Inherency may not be established by probabilities or possibilities. Instead, to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. MPEP 2112. Therefore, the Final Office Action has failed to meet its burden of proof that the features of claim 4 are inherently disclosed in any of the applied references.

As another example, the Final Office Action asserts that because Singh discloses that retrieved information can be merged with materials that are found earlier (i.e., a "Bookshelf" that serves as a long-term repository for retrieved objects), and that users of Singh's system can share their Bookshelf, Singh discloses using the hit-list to "create a community," as recited in claim 19. See Final Office Action, page 11. However, such an assertion is incorrect.

As defined, for example, in paragraph [0041], a "community is a group of people sharing a common interest, skill or other attribute" (emphasis added). See Specification, paragraph [0041]. Singh's alleged hit-list creates a Bookshelf which stores "retrieved objects worthy of retention." These retrieved objects may not have *any* attributes in common. Furthermore, the claimed community is *created* using the hit-list. In contrast, Singh's users merely *share retrieved resources* from Singh's alleged hit-list

on their Bookshelf based on whether the user has access to the Bookshelf. Therefore, the applied references fail to teach or suggest that “the hit-list is used to create a community,” as recited in claim 19.

For at least these reasons, withdrawal of the rejection of claims 1-5, 7-13, 19-20, 25-31, and 33-36 is respectfully requested.

D. Rejection of Claims 6, 14-18 and 32 under 35 U.S.C. § 103(a)

The Final Office Action rejects claims 6, 14-16, 18 and 32 under 35 U.S.C. § 103(a) over Siefert in view of Singh and further in view Coiera and rejects claim 17 under 35 U.S.C. § 103(a) over Siefert in view of Singh in view of Coiera and further in view of Nardozzi. These rejections are respectfully traversed because a *prima facie* case of obviousness has not been established.

As discussed above, Siefert and Singh fail to teach or suggest “creating segments of the hit-list by grouping the resources by one of the attribute dimensions and displaying statistics associated with the segments; receiving a selection of segments through the user interface; and providing a narrowed hit-list by selecting one or more resources from the selected segments,” as recited in independent claims 1 and 25. Furthermore, Coiera and Nardozzi fail to remedy the deficiencies of Siefert and Singh, as they fail to teach or suggest creating segments of the hit-list, as recited in independent claims 1 and 25.

As outlined above, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Final Office Action has failed to clearly articulate a reason why the claim would have been obvious to one of ordinary

skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for claims 6, 14-16, 18, and 32 at least due to their dependence from independent claims 1 and 25.

For at least the above reasons, withdrawal of the rejection of claims 6, 14-16, 18, and 32 is respectfully requested.

F. Conclusion

Applicants respectfully request that the Examiner enter this Amendment under 37 C.F.R. § 1.116, placing claims 1, 3-25, and 27-36 in condition for allowance.

Applicants submit that the proposed amendments do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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